

Attorney Docket No.: P-633 (TI-0020)
Inventors: Taylor and Yu
Serial No.: 09/873,645
Filing Date: June 4, 2001
Page 7

REMARKS

Claims 13-16 are pending in this application. Claims 13-16 have been rejected. Claim 13 has been amended. Support for this amendment is provided in the specification at page 20, lines 7 through 13. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims 13-16 under 35 U.S.C. §112, first paragraph - Lack of Enablement

The rejection of claims 13-16 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, has been maintained. The Examiner suggests that one skilled in the art would not understand what the transformed profile means and what to do with the information after rearranging data of an original profile.

Applicants respectfully traverse this rejection.

At the outset, it is respectfully pointed out that the claims have been amended in accordance with teachings at page 20, lines 7-13 to delete "transforming", stating instead that the system provides for computer implemented adjustment of signal data and time data of a plurality of chromatographic elution

Attorney Docket No.: P-633 (TI-0020)
Inventors: Taylor and Yu
Serial No.: 09/873,645
Filing Date: June 4, 2001
Page 8

profiles to values useful for grouping of the plurality of chromatographic elution profiles method. Thus, the Examiner's concerns regarding those skilled in the art understanding what is meant by "transforming" and "transformed profiles" is now moot.

Further, Applicants believe this amendment makes clear the usefulness of the claimed system - to adjust signal data and time data of a plurality of chromatographic elution profiles to values useful for grouping of the plurality of chromatographic elution profiles method. Various reasons for grouping of a plurality of chromatographic elution profiles are taught in the instant application. Perhaps the most basic and well understood need for grouping is taught at page 24, line 28 through page 25, line 6. There is it taught that raw data comprising a plurality of chromatographic elution profiles generated from DMIPC analysis such as presented in Figures 5, 7, 8 and 21 are impractical for identification of similar profiles. This is due to run-to-run variations resulting from baseline drift, detector signal noise and retention time. One use for the present invention is to provide a system for correcting for such variation by grouping of the varying profiles.

Attorney Docket No.: P-633 (TI-0020)
Inventors: Taylor and Yu
Serial No.: 09/873,645
Filing Date: June 4, 2001
Page 9

MPEP § 2164.01 is clear; any enabled use that reasonably correlates with the scope of the claims is sufficient to preclude a rejection for nonenablement based on how to use.

Also made clear in MPEP § 2164.08 and by the courts is that one does look to the claims but to the specification to find out how to practice the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.* 721 F.2d 1540, 1558, 220 USPQ 303, 316-17 (Fed. Cir. 1983); *In re Johnson*, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977). Suggestions by the Examiner to include in the claims 1) what the information from the shifted profiles means, what distinguishes the shifted profiles from profiles placed originally in the coordinate system, what one does with the information, and 4) criteria for establishing that the profiles should be grouped, are clearly issues related to practice of the claimed invention and thus need not be specifically outlined in the claims since they are clearly taught in the specification. See for example page 27, line 21 through page 31, line 25.

Thus, the instant specification, which clearly teaches one of skill in the art how to make and use the invention as now claimed from the disclosures in the patent application coupled with information known in the art without undue experimentation,

Attorney Docket No.: P-633 (TI-0020)
Inventors: Taylor and Yu
Serial No.: 09/873,645
Filing Date: June 4, 2001
Page 10

meets the enablement requirement of 35 U.S.C. § 112, first paragraph. See MPEP § 2164.01.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph is therefore respectfully requested.

II. Rejection of Claims 13-16 under 35 U.S.C. § 112, second paragraph

Claims 13 through 16 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Examiner suggests that the terms "transform", "transformed", and "transforming" are vague and indefinite because it is unclear what the profiles are being transformed from and what the profiles are being transformed into. Applicants respectfully disagree since the terms "transform", "transformed", and "transforming" are explicitly defined in the specification at page 20, lines 7 through 13. Thus, what is meant by these terms in the claims, is clear when read in light of the teachings of the specification as required by MPEP § 2173.03.

Attorney Docket No.: P-633 (TI-0020)
Inventors: Taylor and Yu
Serial No.: 09/873,645
Filing Date: June 4, 2001
Page 11

However, in an earnest effort to advance the prosecution, Applicants have deleted this term from the claims. Instead, Applicants have amended the claims in accordance with teachings at page 20, lines 7-13 to state that the system provides for computer implemented adjustment of signal data and time data of a plurality of chromatographic elution profiles to values useful for grouping of the plurality of chromatographic elution profiles method.

Claim 13 and claims dependent therefrom are also suggested to be vague and indefinite due to lack of clarity of the term "standardized format".

Thus, in an earnest effort to advance the prosecution of this case, Applicants have deleted this phrase.

Withdrawal of these rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested in light of the amendments to the claims.

III. Rejection of Claims 13-16 under 35 U.S.C. § 112, first paragraph - Written Description

Claims 13-16 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description

Attorney Docket No.: P-633 (TI-0020)
Inventors: Taylor and Yu
Serial No.: 09/873,645
Filing Date: June 4, 2001
Page 12

requirement as the Examiner suggests that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner suggests that specification as originally filed does not teach or suggest what is intended or meant by the term "standardized format" as presently claimed.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have deleted this phrase from the claims.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, for lack of written description is therefore respectfully requested.

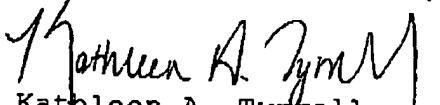
IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending

Attorney Docket No.: P-633 (TI-0020)
Inventors: Taylor and Yu
Serial No.: 09/873,645
Filing Date: June 4, 2001
Page 13

claims is earnestly solicited.

Respectfully submitted,


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